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EXAMINER

PASS, NATALIE

ART UNIT PAPER NUMBER

3626

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Please find below and/or attached an Office communication concerning this application or proceeding.



Art Unit: 3626

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the Board Decision of 27 February 2006 and the response filed 27 April 2006. Claims 1-2 and 16 have been amended. Claims 1-26 are pending.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-6, 8-12, 14-18, 20-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Shelton, United States Patent 7, 028, 049.

(A) Claim 1 has been amended to recite:

- a. “containing information concerning an identified patient,” in the preamble;
- b. “concerning the identified patient,” in lines 4-5, 13, and 14; and
- c. “providing to the requestor, by the identified patient, a patient authorization letter authorizing release of the patient record concerning the identified patient” in lines 8-9.

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As per amended claim 1, Shelton teaches a method of obtaining a patient record containing information concerning an identified patient using an online location on an electronic medium (Shelton; Figure 1, column 9, lines 1-8), comprising:

requesting an order, by a requestor, for the patient record concerning the identified patient from the online location (Shelton; Figure 1, column 9, lines 9-17, 40-45);

providing to the requestor a cover letter having “a tracking number” (reads on “an identifier”) (Shelton; column 12, lines 50-55) , the identifier having order information (Shelton; column 10, lines 28-40, column 10, line 62 to column 11, line 3);

providing to the requestor, by the identified patient, a patient authorization letter authorizing release of the patient record concerning the identified patient (column 11, lines 4-9);

sending, by the requestor, the cover letter along with the patient authorization letter to a “Approvals Agent” (reads on “processing center”), for completing the order (Shelton; column 11, lines 10-30);

requesting, by the “Approvals Agent” (reads on “processing center”), to a “data administrator” (reads on “shipping location”) to “retrieve and transmit” (reads on “ship”) the patient record concerning the identified patient to a destination location) (Shelton; column 12, lines 4-9); and

obtaining, by the requestor, the patient record concerning the identified patient from the destination location (Shelton; column 13, lines 10-27).

(B) As per claims 3-6, 8-9, 21-22, Shelton teaches a method as analyzed and discussed in claim 1 above

wherein the online location comprises a web site (Shelton; column 5, lines 27-31, column 13, lines 22-26);

wherein the requestor comprises an insurance company (Shelton; Figure 1, column 9, lines 9-15);

further comprising inputting patient information in a graphical user interface window before requesting the order (Shelton; column 10, lines 28-35); and

wherein the patient information includes at least one of a claim number, first name, last name, social security number, and date of birth (Shelton; column 10, lines 5-8);

wherein sending the cover letter comprises faxing the cover letter to the processing center (Shelton; column 11, lines 10-20); and

further comprising “automatically obtain[ing] important customized information tailored to each individual data item” (reads on “ automatically reading and identifying, by the processing center, the identifier on the cover letter (Shelton; column 10, line 64 to column 11, line 3);

wherein said cover letter is a “conventional” (reads on “paper”) letter (Shelton; column 10, lines 58-61); and

wherein said patient authorization letter is a “conventional” (reads on “paper”) letter (Shelton; column 10, lines 58-61).

(C) Claim 2 differs from method claim 1, in that it is a system rather than a method for obtaining a patient record containing information concerning an identified patient using an online location.

System claims 2, 10, 11, 12, 14, 23-24 repeat the subject matter of claims 1, 4, 3, 5, 8, 21-22, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claims 1, 4, 3, 5, 8, 21-22 have been shown to be fully disclosed by the teachings of Shelton in the above rejection of claims 1, 4, 3, 5, 8, 21-22 it is readily apparent that the system disclosed by Shelton includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 1, 4, 3, 5, 8, 21-22 and incorporated herein.

(D) As per claim 15, Shelton teaches a system as analyzed and discussed in claim 2 above

wherein sending the cover letter comprises mailing the cover letter to the processing center (Shelton; column 9, lines 33-34, column 10, lines 59-61).

(E) Claim 16 differs from claim 1 in that it is a method of ordering, by a requestor, a patient record containing information concerning an identified patient using an online location rather than a method of obtaining a patient record containing information concerning an identified patient using an online location on an electronic medium.

Claims 16-18, 20, 25-26 repeat the features of claims 1, 4, 5, and 8, 21-22, respectively, and are therefore rejected for the same reasons given above in the rejections of claims 1, 4, 5, and 8, 21-22, and incorporated herein

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 7, 13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelton, United States Patent 7, 028, 049, as applied to claims 1, 2, and 16 above, and further in view of Hacker, United States Patent 6, 988, 075.

(A) As per claim 7, Shelton teaches a method as analyzed and discussed in claim 1 above.

Shelton fails to explicitly disclose a method wherein the identifier comprises a bar code.

However, the above features are well known in the art, , as evidenced by Hacker.

In particular, Hacker teaches a method wherein the identifier comprises a bar code (Hacker; column 6, lines 24-28).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Shelton to include these limitations, as taught by Hacker, with the motivations of providing remote access to electronic medical records by patients or patient-authorized medical providers via a network, such as the Internet, using ordinary browser software and providing patient control over access to their records by using an identifier in order to access the electronic medical record (Hacker; column 6, lines 20-28).

(B) Claim 13 differs from method claim 7, in that it is a system rather than a method for obtaining a patient record containing information concerning an identified patient using an online location.

System claim 13, repeats the subject matter of claim 7, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claim 7 have been shown to be fully disclosed by the combined teachings of Shelton and Hacker in the above rejection of claim 7, it is readily apparent that the system disclosed by Shelton includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 7, and incorporated herein.

The motivations for combining the respective teachings of Shelton and Hacker are as given in the rejection of claim 7 above, and incorporated herein.

(C) Claim 19 teaches a method as analyzed and discussed in claim 16, above. Claim 19 repeats the features of claim 7, respectively, and is therefore rejected for the same reasons given above in the rejections of claim 7, and incorporated herein.

The motivations for combining the respective teachings of Shelton and Hacker are as given in the rejection of claim 7 above, and incorporated herein.

### ***Response to Arguments***

6. Applicant's arguments filed 27 April 2006 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 77 April 2006.



(A) Applicant's arguments on pages 7-9 of the response filed 27 April 2006 with respect to claims 1-26 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied references, Bessette, U.S. Patent Number 6263330, Inga, et al., U.S. Patent Number 5321520, Mayaud, U.S. Patent Number 5845255, Rost, U.S. Patent Number 6725200, Schoenberg, U.S. Patent Number 6463417, and Ballantyne et al., U.S. Patent Number 5867821, teach the environment of authorizing access to medical records.

8. Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington D.C. 20231**

or faxed to: **(571) 273-8300.**

For informal or draft communications, please label  
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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

10. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (571) 272-6776. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (571) 272-3600.

11. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Natalie A. Pass

July 3, 2006



C. LUKE GILLIGAN  
PATENT EXAMINER